

U.S. Patent Application No. 09/843,145

Docket No.: 30014343-1 (1509-179)

REMARKS

Some of the claims have been amended for clarity and claim 38, that is similar to allowable claim 12, but depends on claim 22, has been added. New claim 39 is similar to claim 31. New claim 40 that is similar to claim 22 and can not be interpreted as including passing advertiser details to the consumer but requires passing consumer details to the advertiser device has been added. New claim 41 add the "both" requirement of claim 22 to claim 39. As a result of these changes, applicants submit a Request for Continued Examination (RCE).

The arguments set forth on pages 2 and 3 of the Office Action concerning the applicability of Scheer, U.S. Patent Publication 2002/0161674, filed May 29, 2001, a date subsequent to applicants' filing date, are incorrect. The Office Action includes an alleged quote from the Manual of Patent Examining Procedure (MPEP), but does not provide the MPEP § from which the quote is obtained. It is apparent to attorney for applicants that the provision of the MPEP in quotes is for the benefit of the applicant of the application that claims priority, not for the use of the provisional application as a reference.

35 U.S.C. 102 indicates the position of the Examiner is incorrect. In this regard, the applicable provision of 35 U.S.C. 102 state that a person shall be entitled to a patent unless the invention was described in a printed publication in this or a foreign country before the invention thereof by the applicant for patent (subsection (a)), or the invention was described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the date of the application for patent in the United States (subsection (b)), or the invention was described in an application for

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patent, published under §122(b), filed by another in the United States before the invention by the applicant for patent (subsection (e)). There is no proof in the record that the subject matter disclosed in the provisional application was known by others in this country prior to the applicants' filing date or that the provisional application is a printed publication describing applicants' invention. The provisional application is not a printed publication that was printed more than one year prior to the applicants' foreign priority date. The provisional application was not a published application under §122(b); §122(b) relates to publishing regular applications.

MPEP 706.02V.(D) indicates that the effective filing date of a provisional application is the filing date of the provisional application for any claims of the application of the same applicant which are fully supported by the first paragraph of 35 U.S.C. §112. If the Examiner is relying on this provision of the MPEP, he has a burden to prove that the claims of publication 2002/0161674 are fully supported by the provisional application.

Attorney for applicants is of the opinion that 706.02V.(D) incorrectly states the law. When the CCPA (the predecessor of the Court of Appeals for the Federal Circuit) considered a similar situation in connection with 35 U.S.C. §119, in a case dealing with foreign priority, the Court ruled the effective filing date, for reference purposes, of an application claiming foreign priority is the filing date of the U.S. application, not the foreign priority date. The language of 35 U.S.C. §119(e)(1) is very similar to that of 35 U.S.C. §119(a). In this regard, 35 U.S.C. §119(e)(1) states:

An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed

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under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application.

35 U.S.C. §119(a) states:

An application for patent of an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed;

Both 35 U.S.C. §119(e)(1) and 35 U.S.C. §119(a) have the critical language "shall have the same effect." This is the reason why MPEP §706.02V.(C) states "The filing date of the foreign priority document is not the effective filing date..."

It is incumbent on the Examiner to provide applicants with a copy of the provisional application 60/263,317, cited in Sheer, U.S. Patent Publication 2002/0161674, and to indicate the pertinent portions of the provisional application that are applicable. It is the experience of the undersigned attorney for applicants that the disclosures in provisional and non-provisional applications are frequently very different from each other.

It is improper for the Examiner to assume that the provisional and non-provisional applications are the same. This is particularly true in the present case, where the

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Examiner relies on a single paragraph of a document having 268 paragraphs to disclose a key feature of applicants' claim 1. The Examiner has the burden of proving that the provisional application includes a statement that is the same as or similar to the statement of paragraph 256 of the published application, the only portion of the Scheer published application on which the Examiner relies.

Further, the first full paragraph on page 3 of the Office Action is incorrect in saying paragraph [0256] of Scheer discloses the claim 1 requirement for changing message data of the reply at the broker device. This paragraph of Scheer states that broker 10 receives the "subscribed" performative and sends the "subscribed" performative to the distributor agent server 12 to inform the distributor to send the status change messages when they occur. In other words, broker 10 sends the "subscribed" performative to the distributor agent server in exactly the same form that the broker receives the subscribed performative. There can be no change in the message data that the broker device sends to the advertiser device because the broker device sends exactly the same message data to the distributor agent that the broker received.

To reject claim 31, which depends on claim 1, the Examiner states Rautila et al. discloses a broker device that changes the message sent by the consumer device by augmenting the message sent by the consumer device to enable modification of any follow-up message sent by the advertiser device. However, this position vis-à-vis claim 31 is contrary to the admission the Examiner makes in rejecting claim 1 on Rautila et al., USP, 6,549,625, in view of Scheer, U.S. Patent Publication 2002/0161674. In the rejection of claim 1, the Examiner admitted Rautila et al. does not specifically teach changing message data of the reply at the broker device. Claim 31 indicates the broker

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device changes the message data sent by the consumer device by augmenting the message data in the reply message sent by the consumer device to the broker device. New claim 39 is similar to claim 31, but claim 39 indicates the broker device changes the message data by deleting some of the message data sent by the consumer device.

The reliance on col. 10, lines 1-8, and 58-64, and col. 5, lines 39-51, of Rautila et al. for the foregoing features of claims 31 and 39 is incorrect. Col. 10, lines 1-8 of Rautila et al. merely indicates the server in IP network 26 checks the signature and decrypts the transmission information from mobile terminal 12 and determines if the time stamp in the transmission is valid. If all of this information is verified, the server in network 26 concludes, with a high probability, that the user of mobile terminal 12 is an authorized user and provides the user of terminal 12 with access to the database in the server. Certainly, this portion of Rautila et al. is irrelevant to claim 31. Col. 10, lines 58-64, indicates the changed data are sent to the consumer, not to the broker. The same is true of Rautila et al. at col. 5, lines 39-51. Col. 5, lines 49-51, states the database of network 26 transmits stored information associated with identification information that is in mobile terminal 12 to the second transceiver that is in mobile terminal 12. Col. 4, lines 59-61, indicates the mobile terminal includes the first and second transceivers. Since the mobile terminal is not considered by the Examiner as the broker, the limitations of claim 31 are not found in Rautila et al.

In addition, the requirements for claims 27-29 are not found in Rautila et al.. Claim 27 indicates the change to the reply message that the broker sends to the advertiser includes augmenting the reply message, while claim 28 indicates the change to the reply message includes modifying the original text or the reply message, and

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claim 29 indicates the original text is modified by removing an identifier of the consumer. The Office Action groups claims 27-29 with claim 1. However, the discussion of claims 1 and 27-29 fails to mention the foregoing features of claims 27-29. Certainly Scheer et al. does not disclose the changes in the reply message set forth in claims 27-29 and there is no indication from the Office Action as to where such changes can be found in Rautila et al.

Based on the foregoing, the rejection of claim 1 and the claims dependent thereon, that is, claims 2-5, 7-11, 14, 27-31 and 33, based on Rautila et al. and Scheer is incorrect. Further, applicants have shown why the rejection of claims 27-29 and 31 is incorrect.

Applicants traverse the rejection of claims 1-5, 7-11, 14, 27-31 and 33 as being obvious as a result of Rautila et al. in view of Todd, USP 6,785,682. Todd is relied on to disclose the feature the Examiner admits Rautila et al. does not disclose, i.e., changing message data of the reply at the broker device.

In this rejection, as in the rejection based on Rautila et al. and Scheer, the Examiner admits Rautila et al. fails to disclose changing message data of a reply at a broker device. However, claim 1 indicates the changed reply message is communicated from the broker device to the advertiser device. In Rautila et al., as indicated in the Office Action, an acknowledgement is communicated from the broker device to the advertiser device, not a changed reply message that results from changing the message data of a reply message at a broker device, as claim 1 requires. The portion of Todd relied on in the Office Action, col. 5, lines 58-64, merely indicates a message broker may change an underlying data structure which (a) simply associates

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or adds one message to another message, (b) replaces a previously stored message with a newly received message, (c) updates a currently stored message with a newly received message or (d) creates a new message within the data structure. Hence, Todd does not disclose communicating a changed reply message at a broker device and communicating the changed reply message from the broker device to the advertiser device. Consequently, the proposal to modify Rautila et al. as a result of Todd does not meet the terms of claim 1.

Claims 27-29 and 31 are improperly rejected. Apparently, the Examiner relies on Rautila et al. to reject these claims, in the same way that Rautila et al. was relied on the rejection based on Rautila et al. and Scheer. However, as pointed out above, Rautila et al. is improperly relied on in this regard.

In the rejections of claim 33, based on Rautila et al. and Scheer, as well as Rautila et al. and Todd, the Examiner states that claim 33 is rejected for the same reasons as discussed above with respect to claim 22. However, there was no rejection of claim 22 in the rejections based on Rautila et al. in view Scheer or in the rejection of Rautila et al. in view of Todd.

The rejection of claims 20, 21, 32 and 34 based on Rautila et al. in view of Konishi, USP 5,301,273, is again traversed. Firstly, claim 34 is rejected on this combination of references, but it depends on claim 22. There is no rejection of claim 22 based only on Rautila et al. or based on Rautila et al. and Konishi. Consequently, the rejection of claim 34 is incorrect on its face.

Concerning the rejection of claims 20, 21 and 32 (wherein claims 21 and 32 depend on claim 20), the Office Action, on page 4, states col. 2, lines 55-57, of Konishi

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discloses receiving an advertisement message because Konishi discloses the fact that a response message corresponding to a transmitted message using this address information is not received. It is not seen how such a statement has anything to do with the advertising requirement of claim 20. Explanation is required.

Applicants traverse the rejection of claims 22, 25, 26 and 37 as being obvious as a result of Rautila et al. in view of Paltenghe et al., U.S. Patent Publication 2001/0011250. In this rejection, the Office Action in the parenthetical sentence in the first full paragraph on page 12, states that the Examiner considers the "claimed or" in line 8 of claim 22 as a simple alternative "or." Applicants do not understand this comment. Claim 22, line 8, includes a coil that reads "the memory or the processor of the consumer device having an advertisement receiver." This clause clearly means that either the memory or the processor of the consumer device has an advertisement receiver. Applicants agree that this is a simple alternative phrase, but do not understand how the Examiner construes it to mean "advertiser details to the consumer device." Explanation is requested.

Applicants are unable to understand the rejection of claims 22, 25, 26 and 37. In this rejection, the Examiner relies on Rautila et al. and Paltenghe et al., and admits Rautila et al. does not disclose blocking the passage of advertiser details to a consumer device. The Office Action states: "Paltenghe et al. teaches that block passage of advertiser details to the consumer device (col. 5, lines 58-64). (sic)" Applicant is unable to find col. 5, lines 58-64 in Paltenghe et al. Paragraph 5 refers to the background of the invention and discusses the annoyance of consumers receiving a barrage of catalogs. The fifth column of the published patent application, on page 3 thereof, does

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not include 64 lines; the last several lines of this column discuss the use of fuzzy logic matching to match merchants and consumers on an anonymous basis so that neither knows the identity of the other, so negotiations can occur anonymously. The first column on page 5 of the reference also does not include 64 lines. Lines 58-63 discuss a current public key infrastructure which is promoted by various vendors and that involves certificate authorities. Lines 58-63 of the second column on page 5 indicate information bank 23 operates in a secured environment to eliminate questions related to software integrity, and provides access to all required CRLs and routes the certificates from an appropriate directory structure. Claim 5 of Paltenghe et al. is concerned with an authorizing means for allowing selected users access to use of dynamic personal information data. It is not seen how any of the foregoing portions of Paltenghe et al. are at all related to the subject matter that the Examiner admits Rautila et al. does not disclose and that is in claim 22. If Paltenghe et al. is relied on again for such a disclosure, proper identification of the portion of Paltenghe et al. relied on is necessary.

The remaining claims are dependent claims and are allowable for the same reasons advanced for the claims upon which they depend. In view of the foregoing amendments and remarks, allowance is in order.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

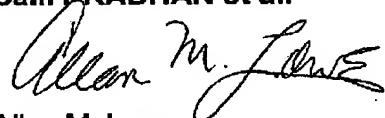
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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 08-2025 and please credit any excess fees to such deposit account.

Respectfully submitted,

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